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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/936,557

01/02/2002

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09/16/2008

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EXAMINER

KE, PENG

ART UNIT

PAPER NUMBER

2174

MAIL DATE

DELIVERY MODE

09/16/2008

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/936,557
Filing Date: January 02, 2002
Appellant(s): KRAFT, CHRISTIAN

Kraft
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/24/08 appealing from the Office action mailed 5/24/07.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|--------------|----------------|--------|
| WO 97/19429 | Deluca et al., | 5-1997 |
| US 6,044,248 | Mochizuki | 3-2000 |
| US 6,421,707 | Miller et al. | 7-2002 |

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| | | |
|--------------|--------------|--------|
| US 6,032,025 | Sugio et al. | 2-2000 |
| US 6,407,828 | Medina | 6-2002 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 29, 39, 40, 43, 45, 46, 49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deluca et al., International Publication No. WO 97/19429 in view of Mochizuki US Patent 6,044,248 further in view of Miller US Patent 6,421,707.

As per claim 15, Deluca teaches a method for handling messages transmitted between communication terminals via a wireless network comprising:

generating a compound message including a text part and at least one graphical icon part, (see page 5, lines 13-14; Examiner interprets the image generated by the text #07 to be an icon)

the compound message generation including reading a user inputted text part (see page 5, lines 13-21; Examiner interprets “#07Tom?” to be a compound message) and

converting the inputted text part into a predefined message text format, (see page 10, lines 15-22; Examiner interprets the house address and the telephone number to be predefined text messages because they are automatically generated based on upon user selection)

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transmitting of the message via the wireless network (see page 3, lines 2-15; Examiner interprets radio communication network to be a wireless network).

However, Deluca fails to teach adding graphical part to the message, the graphical part including a record for each of the at least one graphical icon part in a graphical format;

and adding position information in the message defining a position of the at least one graphical icon part in the text part.

Mochizuki teaches adding graphical part to the message, the graphical part including a record for each of the at least one graphical icon part in a graphical format; (column 4, lines 63-column 5, lines 8)

and adding position information in the message defining a position of the at least one graphical icon part in the text part (column 5, lines 6-20)

It would have been obvious to an artisan at the time of the invention to include Mochizuki's teaching with method of Deluca in order to allow users to send customized formatted message.

However, Both Deluca and Mochizuki both fail to teach graphical icon part is in a graphical format.

Miller et al. teaches transmitting messages that include graphical image. (column 1, lines 38-70)

It would have been obvious to an artisan at the time of the invention to include Miller's teaching with method of Deluca and Mochizuki in order to allow users to transfer image files. (see Miller; column 1, lines 31-35)

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As per claims 29 and 39, they are rejected with the same rationale as claim 1. (see rejection above)

As per claim 40, which is dependent on claim 15, Deluca, Mochizuki, and Miller teach method of claim 15. Mochizuki further teaches wherein the position information further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text is positioned prior to the at least one graphical icon part and at least another portion of the text part is positioned following the at least one graphical icon part. (see Mochizuki, figure. 9 (a-d), column 5, lines 6-20)

As per claim 43, which is dependent on claim 29, it is of the same scope as claim 40. Supra.

As per claim 45, which is dependent on claim 39, it is of the same scope as claim 40. Supra.

As per claim 46, which is dependent on claim 15, Deluca, Mochizuki, and Miller teach method of claim 15. Miller further teaches at least one graphical icon part comprises at least one of an image or a picture. (see Miller; column 1, lines 31-35)

As per claims 49 and 51, they are of the as same scope as claim 46.

Claims 52, 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deluca et al., International Publication No. WO 97/19429 in view of Mochizuki US Patent 6,044,248 further in view of Miller US Patent 6,421,707 further in view of Sugio et al. US 6,032,025.

As per claim 52, which is dependent on claim 15, Deluca, Mochizuki, and Miller teaches method of claim 15. They fail to teach graphical part comprises an animation sequence.

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Sugio teaches graphical part comprises an animation sequence. (see Sugio, column 42, lines 19-22)

It would have been obvious to an artisan at the time of the invention to include Sugio's teaching with method of Deluca, Mochizuki, and Miller in order to allow users to transfer animation sequences.

As per claims 55 and 57, they are of the as same scope as claim 46.

Claims 16, 19-25, 30, 33-38, 41, 42, 44, 47, 48, 50, 53, 54, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugio et al. US 6,032,025 in view of Mochizuki US 6,044,248 further in view of Miller US Patent 6,421,707.

As per claim 16, Sugio teaches a communication terminal for handling messages and comprising:

a controller,

a transceiver for communicating with a wireless communication network, and

a user interface through which the user operates the terminal, the user interface including a display (see Sugio, column 2, lines 30-50),

message editor application allowing the user to generate a compound message including a text part and at least one graphical icon part; (see Sugio, column 2, lines 30-42 and column 7, lines 29-60) and

wherein the controller generates the compound message for being transmitted via the transceiver (see Sugio, column 2, lines 34-36) including

a text part in a predefined message text character format (see Sugio, column 7, lines 41-42),

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However, Sugio fails to teach information in the message defining a position of the at least one graphical icon part in the text part.

Mochizuki teaches information in the message defining a position of the at least one graphical Icon part in the text part. (see Mochizuki, column 5, lines 6-20)

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the method of Mochizuki with the method of Sugio in order to allow more user control over used screen space.

However, Both Deluca and Mochizuki both fail to teach a graphical part including a record for each of the at least one graphical icon part in a graphical format.

Miller et al. teaches transmitting messages that include graphical image. (column 1, lines 38-70)

It would have been obvious to an artisan at the time of the invention to include Miller's teaching with method of Deluca and Mochizuki in order to allow users to transfer image files. (see Miller; column 1, lines 31-35)

As per claim 19, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 16. Sugio further teaches wherein the message editor application allows the user to copy a pre-stored graphical Icon from a memory associated with the controller and containing a plurality of clip art graphical icons. (see Sugio, column 6, lines 27-42 and column 7, lines 48-52)

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As per claim 20, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 16. Sugio further teaches the communication terminal comprising a message reader application for automatically converting a received compound message into a displayable format based on the text part and the at least one graphical icon part. (see Sugio, column 9, lines 7-22).

As per claim 21, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 19. Sugio further teaches the method wherein the message reader application includes means for allowing the user to store the at least one graphical part in the memory associated with the controller and containing a plurality of graphical icons. (see Sugio, column 6, lines 27-34)

As per claim 22, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 16. Sugio further teaches wherein the message editor application allows the user to manually generate a graphical icon on the display by selectively marking dots in an icon matrix. (see Sugio, column 17, lines 36-43)

As per claim 23, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 22. Sugio teaches wherein the message editor application allows the user to store a manually entered graphical icon in the memory associated with the controller and containing a plurality of graphical icons. (see Sugio, column 18, lines 29-35)

As per claim 24, Sugio, Mochizuki, and Miller teach a communication terminal claim 16. Sugio further teaches wherein the message editor application allows the user to input a plurality of graphical parts in the graphical part of the message and information in the message to display the plurality of graphical parts as an animation sequence. (see Sugio, column 42, lines 19-22)

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As per claim 25, it is rejected with the same rationale as claim 16. Supra

As per claim 30, it is rejected with the same rationale as claim 16. Supra

As per claim 33, which is dependant on claim 30, it is of the same scope as claim 19.

Supra.

As per claim 34, which is dependant on claim 30, it is of the same scope as claim 20.

Supra.

As per claim 35, which is dependent on claim 30, it is of the same scope as claim 21.

Supra.

As per claim 36, which is dependent on claim 30, it is of the same scope as claim 22.

Supra.

As per claim 37, which is dependent on claim 30, it is of the same scope as claim 23.

Supra.

As per claim 38, which is dependent on claim 30, it is of the same scope as claim 24.

Supra

As per claim 41, which is dependent on claim 16, Sugio, Mochizuki, and Miller teach a communication terminal claim 16. Mochizuki further teaches wherein the position information further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text is position prior to the at least one graphical icon part and at least another portion of the text part is position following the at least one graphical icon part. (see Mochizuki, figure. 9 (a-d), column 5, lines 6-20)

As per claim 42, which is dependent on claim 25, it is of the same scope as claim 41.

Supra.

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As per claim 44, which is dependent on claim 30, it is of the same scope as claim 41.

Supra.

As per claim 47, which is dependent on claim 16, Sugio, Mochizuki, and Miller teach method of claim 16. Miller further teaches at least one graphical icon part comprises at least one of an image or a picture. (see Miller; column 1, lines 31-35)

As per claims 48 and 50, they are of the same scope as claim 47.

As per claim 53, which is dependent on claim 16, Sugio, Mochizuki, and Miller teach method of claim 16. Sugio further teaches at least one graphical icon part comprises an animation sequence. (see Sugio, column 42, lines 19-22)

As per claims 54 and 56, they are of the same scope as claim 53.

Claims 17, 18, 26, 27, 28, 31, and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Sugio et al. US 6,032,025 in view of Mochizuki US 6,044,248 further in view of Miller US Patent 6,421,707 further in view of Medina US 6,407,828.

As per claim 17, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 16. However, Sugio, Mochizuki, and Miller do not teach wherein the message generated by the controller includes the position information. Medina teaches wherein a message includes a header part including position information of graphics. (see Medina, column 3, lines 34-66) It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Sugio, Mochizuki, and Miller with the method Medina in order to allow image data and text data to be properly reconstructed into their proper special relationships

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As per claim 18, Sugio, Mochizuki, Miller and Medina teach a communication terminal according to claim 17. Medina teaches wherein the header part of the message furthermore includes information about graphics size. (see Medina, column 3, lines 34-66)

As per claim 26, Sugio, Mochizuki, Miller and Medina teach a communication terminal according to claim 17. Sugio teaches wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons. (see Sugio, column 6, lines 27-42 and column 7, lines 48-52)

As per claim 27, Sugio, Mochizuki, Miller and Medina teach a communication terminal according to claim 18. Sugio teaches wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons. (see Sugio, column 6, lines 27-42 and column 7, lines 48-52)

As per claim 28, which is dependent on claim 17, it is of the same scope as claim 18.

Supra

As per claim 31, which is dependent on claim 30, it is of the same scope as claim 17.

Supra

As per claim 32, which is dependent on claim 31, it is of the same scope as claim 18.

Supra

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Appellant's argument focused on the following:

A) Claims 15, 29, 39, 40, 43, 45, 46, 49, and 51.

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1) Whether Deluca, Mochizuki and Miller teach “generating a compound message including a text part and at least one graphical icon part?”

1) The examiner does not agree for the following reasons:

During patent examination, the pending claims must be "given >their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

In this case, the claim recites “generating a compound message including a text part and at least one graphical icon part,” and Deluca teaches this limitation because Deluca allows users to generate a message with a textual content and a graphical icon code for creating an icon. (see Deluca, Page 5, lines 10-27) Furthermore, even if a graphical icon code cannot be considered as a graphical icon part, the combination of Deluca and Miller teaches a message including a graphical icon part. Miller allows users to transmit a graphical object using electronic messages, (see Miller, col. 4, lines 25-40) and therefore by combining Miller's teaching with method of Deluca, the combination teaches a compound message with a text content and a graphical object that is attached to the message.

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2) Whether Deluca, Mochizuki and Miller teach “adding a graphical part to the message, the ... graphical part including... at least one graphical icon part in a graphical format, ...the ... graphical icon part in the text part?”

2) The combination of Deluca and Miller teaches “adding a graphical part to the message, the ... graphical part including... at least one graphical icon part in a graphical format, ...the ... graphical icon part in the text part.” Deluca teaches generating a message with a textual content and a graphical icon code for creating an icon,” (see Deluca, Page 5, lines 10-27) and Miller allows users to transmit a graphical part in a graphical format using electronic messages. (see Miller, col. 4, lines 25-40) Therefore by combining Miller's teaching with the method of Deluca, the combination teaches adding a graphical part to the message, the graphical part including at least one graphical icon part in a graphical format, the graphical icon part in the text part.

3) Whether Deluca, Mochizuki and Miller teach “transmitting of the message via the wireless network?”

3) Deluca teaches transmitting of the message via the wireless network because it allows users to transmit message over a wireless network. (see Deluca col.3, lines 2-25; col. 1, lines 10-25)

B) Claims 16, 19-25, 30, 33-38, 41, 42, 44, 47, 48, 50, 53, 54, and 56.

1) Whether Sugio, Mochizuki and Miller teach “generating a compound message including a text part and at least one graphical icon part?”

1) The examiner does not agree for the following reasons:

During patent examination, the pending claims must be "given >their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372,

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54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

In this case, the claim recites “generating a compound message including a text part and at least one graphical icon part,” and Sugio teaches this limitation because Sugio allows users to generate a message with a textual content and a graphical icon code for creating an icon.” (see Sugio, col. 2, lines 30-42, col. 7, lines 29-60) Furthermore, even if a graphical icon code cannot be considered as a graphical icon part, the combination of Sugio and Miller teaches a message including a graphical icon part. Miller allows users to transmit a graphical object within a electronic messages, (see Miller, col. 4, lines 25-40) and therefore by combining Miller's teaching with method of Sugio the combination teaches a compound message with a text content and a graphical object that is attached to the message.

2) Whether Sugio, Mochizuki and Miller teach “adding a graphical part to the message, the ... graphical part including... at least one graphical icon part in a graphical format, ...the ... graphical icon part in the text part?”

2) The combination of Sugio and Miller teaches “adding a graphical part to the message, the ... graphical part including... at least one graphical icon part in a graphical format, ...the ... graphical icon part in the text part.” Sugio teaches generating a message with a textual content

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and a graphical icon code for creating an icon,” (see Sugio, col. 2, lines 30-42, col. 7, lines 29-60) and Miller allows users to transmit a graphical part in a graphical format using electronic messages. (see Miller, col. 4, lines 25-40) Therefore by combining Miller's teaching with the method of Sugio, the combination teaches adding a graphical part to the message, the graphical part including at least one graphical icon part in a graphical format, the graphical icon part in the text part.

3) Whether Sugio, Mochizuki and Miller teach “transmitting of the message via the wireless network?”

3) Sugio teaches transmitting of the message via the wireless network because it allows users to transmit message over a wireless network. (see Sugio col.5, lines 35-70)

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Peng Ke

/Peng Ke/

Examiner, Art Unit 2174

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